REMARKS

The Examiner has required a restriction between the claims of Group I – Group XI as set forth in detail on pages 2-7 of the Office Action. This requirement is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants submit that the Examiner's Restriction Requirement is improper for the following reasons.

1. The Examiner has Misapplied PCT Rule 13.1

Applicants submit that contrary to the Examiner's analysis, the present claims are indeed linked by a special technical feature and comply with PCT Rule 13.1.

The Examiner will first of all note that no unity of invention objection was raised during the International Phase of this application. Applicants submit that a similar finding should apply to this National Phase application.

Secondly, the common inventive aspect which links the claims is not anticipated by the prior art cited by the Examiner. For example, *Weitz et al.* does not even mention the tumor associated antigens and *Nakashio et al.* only mentions tumor associated antigens of a type that are not useful in the present invention. In addition, use of a carbohydrate tumor associated antigen (see for example claim 25) is generic to and links all the claims which are directed to Lewis Y, Globo H, Sialyl TN, GD2 and GD3, identified by the Examiner as Groups IV-VIII.

Thus, there is indeed a common inventive concept which links all of the groups of claims and it has been shown that the Examiner's reasoning is incorrect in attempting to show that there is not a common inventive technical feature to link the groups of claims. As such, Applicants submit that the Examiner's Restriction Requirement should be withdrawn.

This action is further compelled by proper compliance of the USPTO with the provisions of the Patent Cooperation Treaty. As noted above, no unity of invention objection was raised

during the International Phase of this application. An international application which complies with the PCT unity of invention requirements must then be accepted by all of the designated and elected offices including the USPTO, since Article 27 (1) of the Patent Cooperation Treaty does not permit any national law or national office to require compliance with different regulations relating to the contents of the international application. Thus, the U.S. application must be examined for unity of invention consistent with the Patent Cooperation Treaty, not just by citation to PCT rules or apparent verbal assent to the standard, but rather in actual application and compliance of the standard. (see *Caterpillar Tractor Co. v. Commission of Patent and Trademarks*, 231 USPQ 590 (E.D.VA. 1986).

2. The Examiner's Requirement Fails to Comply with U.S. Case Law Precedent

In making the restriction requirement, the Examiner also attempts to break up Applicants' generic claims, and thereby apparently refuse to examine Applicants' proper generic claims. In particular, Groups I-VII and Group IX are each only directed to claim 17, and the Examiner attempts to limit the claims to a specific type of antibody. In addition, in Group VIII the Examiner seems to suggest limiting the claim to only an antibody "specific for GD3 during surgery", without recognizing the generic nature of Applicants' claim 1 and other claims. These actions represent an improper attempt by the Examiner to break up Applicants' generic claims, which is not at all the purpose of a restriction requirement. Under 35 U.S.C. § 121, an Examiner can make a restriction requirement between different groups of claims but cannot properly restrict an application by dividing up the subject matter of a single generic claim by making a restriction within that claim. An Examiner may not, in this manner, simply refuse to make an examination on the merits of a broad generic claim. Such a refusal is tantamount to attempting to reject the claim under 35 U.S.C. § 121, a rejection which has been viewed with disapproval by the court. The incorrectness of the Examiner's apparent reasoning was specifically explained by Judge Rich:

> "it is elementary patent law that the number of "species" "covered" by a patent having a generic claim is virtually without limit not withstanding the

> limitation of rule 141 to five species "specifically claimed". So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim – no matter how broad, which means no matter how many independently patentable inventions may fall within it." *In re Weber*, 198 USPQ 328, 331-332 (CCPA 1978).

3. Requesting an Election of Species is the Proper Procedure in this Application

Rather than attempting to break up Applicants' generic claims, the proper procedure for the Examiner is to request the election of an individual species. This is the procedure set forth in M.P.E.P. § 803.02, whereby the Examiner can require the Applicant to elect a single individual species to begin the search and examination. But upon a determination that a claim directed to the elected species is patentable, then the search and examination must be expanded to other species encompassed by the generic claim.

4. Conclusions

Applicants submit that the Examiner's attempt at a restriction requirement is improper for the reasons discussed in detail above. In addition, Applicants submit that the appropriate procedure for the Examiner is to require the Applicants to elect a single disclosed species from which to initiate prosecution.

Therefore, Applicants elect the species represented by an antibody against the Lewis Y antigen as the species from which to initiate prosecution. New claim 27 is specifically directed to that elected species. The Examiner will note that claim 28 is specifically directed to the method utilizing the antibody to a Lewis Y antigen, and specifically administering the antibody during surgery. In addition, Applicants submit that all of the claims are readable on that elected species, namely on the use of an antibody to Lewis Y.

However, should the Examiner maintain the restriction requirement as set forth in the Office Action, in order to be in full compliance with the requirement, Applicants elect, with

traverse, the invention identified in the Office Action as Group IV, namely administering an antibody specific for Lewis Y during surgery.

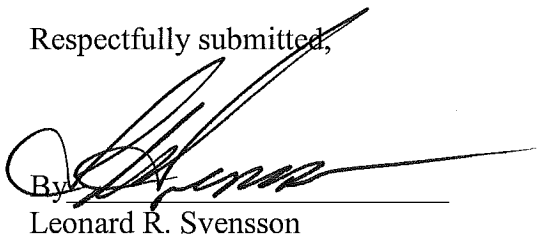
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of $120.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson, Registration No. 30,330 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: May 24, 2007

Respectfully submitted,



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